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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,527	02/12/2002	Peter J. Olandt	MPI01-018P1RNM	6686

7590

04/22/2003

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EXAMINER

RAO, MANJUNATH N

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,527

Applicant(s)

OLANDT ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 12, 18 drawn to polynucleotides, vectors, host cells, kit and a method of making the polypeptide, classified in class 435, subclass 69.1.
- II. Claims 9-11, drawn to polypeptides, classified in class 435, subclass 193.
- III. Claim 11, and 15 drawn to an antibody, classified in class 530, subclass 387.1.
- IV. Claims 13-14, drawn to a method for detecting the presence of the polypeptide in a sample, classified in class 435, subclass 7.1.
- V. Claim 16-17, drawn to a method for detecting the presence of the polynucleotide in a sample, classified in class 435, subclass 6.
- VI. Claim 19-20, drawn to a method for identifying a compound that binds to the polypeptide, classified in class 435, subclass 4.
- VII. Claim 21, drawn to a method for modulating the activity of a polypeptide, classified in class 435, subclass 4.
- VIII. Claim 22, drawn to a method for identifying a compound which modulates the activity of a polypeptide, classified in class 435, subclass 4.
- IX. Claim 23, drawn to a composition of unknown structure for treating atherosclerosis, classified in class 514, subclass 789.
- X. Claim 24, drawn to a method for treating atherosclerosis disorder by administering the compound that modulates the expression or activity of 33945, classified in class 435, subclass 278.1.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IX are patentably distinct from each other. The polypeptide of group II, the polynucleotide of group I, the antibody of group III, the treatment composition of group IX each comprise amino acid sequences and nucleotide sequences which are chemically unrelated, do not require each other for practice; have separate utilities, such as use of the group II polypeptide to catalyze a transferase reaction versus the use of polynucleotide in a hybridization reaction, versus the use of the antibody in a protein purification reaction versus the use of compound in treatment of atherosclerosis disorder and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions IV, V, VI, VII, VIII, X are patentably distinct from each other. The method of detecting the polypeptide of group IV, the method of detecting the polynucleotide of group V, the method of identifying a compound that binds to the polypeptide of group VI, the method of modulating the activity of the polypeptide of group VII, the method of identifying a compound that modulates the activity of the polypeptide of group VIII and the method of treating atherosclerosis disorder of group X are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Invention I and IV, VI, VII, VIII, X are patentably distinct from each other. The polynucleotides of group I is neither made nor used in the methods of groups IV, VI, VII, VIII,

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X. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides can be used for making recombinant proteins as opposed to its use in the method of group V.

Inventions II and IV, VI through VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of group II can be used for making specific antibodies as opposed to its use in the methods of groups IV, VI through VIII.

Inventions III and IV, VI through VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of group III can be used for

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purifying the polypeptide by affinity chromatography as opposed to its use in the methods of groups IV, VI through VIII.

Inventions IX and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compound used to treat atherosclerosis can be used as inhibitor of the glycosyltransferase in a enzymatic reaction as opposed to its use in the method of group X.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

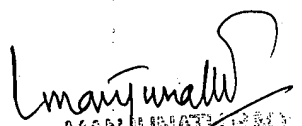
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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.


MANJUNATH RAO
PATENT EXAMINER

Manjunath N. Rao
April 4, 2003